

REMARKS

By this amendment, claims 3 and 6 are revised to place this application in condition for allowance. Currently, claims 1-18 are before the Examiner for consideration on their merits.

In the outstanding Office Action, the Examiner noted instances of a lack of antecedent basis in claim 3 and an informality in claim 6. Each of these issues has been corrected by the amendments made above, and withdrawal of the rejection and objection is respectfully requested.

Turning now to the prior art rejection, the Examiner maintains the rejection in terms of relying on the Kemp and Crosby prior art references. Claims 1-7 stand rejected under 35 U.S.C. § 102(e) based on Kemp, while claim 1 is rejected under 35 U.S.C. § 102(b) based on Crosby. Claim 2 is now rejected under 35 U.S.C. § 103(a) based on Crosby.

Claims 8-10, 17, and 18 are rejected based on the combination of Crosby and United States Patent No. 5,773,020 to Place et al (Place). In this rejection, the Examiner admits that Crosby does not teach the exact composition claimed and cites Place to allege that the composition is known, and that it would be obvious to use such in place of the composition used in Crosby.

Similarly, claims 8-18 are rejected under 35 U.S.C. § 103(a) based on the combination of Kemp and Place for the same reason as set forth above for claims 8-10, 17, and 18. That is, it would be obvious to substitute the composition of Place for that used in Kemp.

One important issue in this application is the limitation regarding the immiscibility

of the vasodilator active compound and the lubricant. In light of the importance of this limitation, Applicant's attorney attempted to discuss the issue of immiscibility with the Examiner and conducted telephonic interviews on December 6 and 15, 2005. During these interviews, Applicant's attorney indicated that the reasoning supporting the rejections based on Kemp or Crosby did not appear to address the limitation in claim 1 that the "vasodilator active compound is disposed on the external condom surface in a form or with a composition which is immiscible with the lubricant". Applicant's attorney also mentioned that Crosby was of record during the PCT phase of this application, and the IPER of the PCT indicated that the claims met the requirements of PCT Article 33 with respect to novelty, inventive step and industrial applicability.

The Examiner indicated that she could not review the issue regarding the immiscibility limitation and requested that Applicant provide a written response to the Office Action.

One issue determining patentability in this case is whether the limitation that the "vasodilator active compound is disposed on the external condom surface in a form or with a composition which is immiscible with the lubricant" is found in either Kemp or Crosby. Since these references are relied upon from an anticipation standpoint, the limitation must be found, either expressly or implicitly to support the allegation of anticipation.

Applicant respectfully submits that the rejections are improper since neither Kemp nor Crosby teach or imply the limitation in question. The reasoning supporting the rejection makes no mention as to where explicit support for the contention that the limitation at issue is found in either Kemp or Crosby. In Crosby, the terms "immiscible or

"immiscibility" are not found within the four corners of the document. In fact, there is no disclosure whatsoever about making the vasodilator, in a form or with a composition, that is immiscible with the lubricant. A similar conclusion can be reached for Kemp.

In the rejection, the Examiner states that the broadest reasonable interpretation of the claims mean that the claim requires "A" or "B." This stance is not understood. First, it is not clear as to what "A" and "B" stand for in the rejection. Assuming that the Examiner means that "A" is the vasodilator active compound and "B" is the lubricant, it is not understood how the Examiner could interpret claim 1 to read only on one or the other. To interpret claim 1 to only specify a condom with a lubricant or a condom with a vasodilator active compound ignores express claim language. Ignoring claim language cannot be considered to be the same as claim interpretation. In sum, the Examiner's reasoning regarding claim interpretation is not either improper for failing to consider all of the claim language or just not understood such that clarification is requested.

While there is clearly no express suggestion of the arrangement of claim 1 concerning immiscibility, there is also no basis to conclude that somehow the claim limitation in question is implied in either Kemp or Crosby. With no mention of or even recognition of the importance of the relationship between the lubricant and vasodilator active compound, the Examiner cannot conclude that the limitation is somehow implied in the teachings of either Crosby or Kemp.

In light of the failure of each of Kemp and Crosby to teach explicitly or implicitly teach the claim limitation in question, the Examiner cannot reject claim 1 under 35 U.S.C. § 102(e) or (b).

The Examiner is called upon to support any further rejection of claim 1 with

objective evidence establishing that the claim limitations are found in the prior art, and any further rejection, if made, should be made non-final.

The conclusion of the IPER in the PCT application supports the arguments set forth above. Crosby was not held to teach the invention although it was before the PCT Examiner for consideration of its teachings. Since Kemp is cumulative to Crosby in terms of its teachings regarding the vasodilator active compound, the conclusion regarding the sufficiency of Kemp to establish a *prima facie* case of anticipation must be the same; i.e., it can not.

Lacking a basis to reject claim 1 under 35 U.S.C. § 102, the Examiner's only resort is to rely on 35 U.S.C. § 103(a) to further reject the claim. However, in order to make such a rejection, the Examiner must have the requisite motivation to modify either Kemp or Crosby so as to arrive at the invention. Obviously, the motivation cannot come from Kemp or Crosby since each is silent regarding the limitation at issue. The Examiner has not identified any other reference that is relevant to the issue at hand, and the only conclusion to be drawn is that there is no basis to formulate a rejection under 35 U.S.C. § 103(a). Any allegation that claim 1 is obvious over the prior art of record would be the hindsight reconstruction of the prior art in light of Applicant's disclosure, and this cannot form the basis for a rejection under 35 U.S.C. § 103(a).

The reliance on Place to reject the dependent claims is noted. However, Place does not supply the deficiency in either Crosby or Kemp regarding the immiscibility of the lubricant and vasodilator active compound as claimed, and even if Place were combined with these two prior art references, claim 1 is still not taught or suggested.

In view of the fact that the prior art does not teach each and every limitation of

claim 1 and lacks any teaching to support an obvious contention, the Examiner must withdraw the rejection of claim 1. Furthermore, since the remaining dependent claims are all dependent on claim 1, all claims are now in condition for allowance.

Accordingly, the Examiner is respectfully requested to examine this application in light of this Amendment and pass claims 1-18 onto issuance.

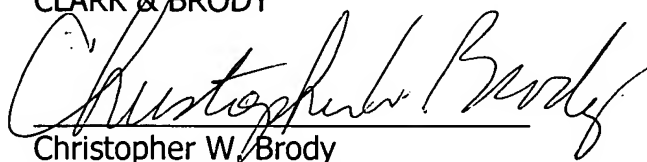
If the Examiner believes that another interview with Applicant's attorney would be helpful in expediting allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated September 19, 2005.

Again, reconsideration and allowance of this application is respectfully requested.

A petition for a one month extension of time is hereby made. Attached hereto is a check in the amount of \$60.00. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in cursive script, reading "Christopher W. Brody", written over a horizontal line.

Christopher W. Brody
Registration No. 33,613

Customer No. 22902
1090 Vermont Ave. NW
Suite 250
Washington, DC 20005
Telephone: 202-835-1111
Facsimile: 202-835-1755
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